89-1866

NO. _____

Supreme Court, U.S.
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IN THE

# Supreme Court of The United States

October Term, 1989

FRANKLIN PIERCE LAW CENTER,
*Petitioner*

v.

GEORGETOWN UNIVERSITY,
*Respondent*

**Petition For A Writ of Certiorari to the United States Court of Appeals For The Federal Circuit**

Robert H. Rines
*Counsel of Record*

Nancy Richards-Stower
RINES AND RINES
81 North State Street
Concord, New Hampshire
(603) 228-0121
*Attorneys for the Petitioner*

## QUESTIONS PRESENTED FOR REVIEW

1. In the face of Congressional enactment of a statutory test of "distinctiveness" for protecting descriptive trademarks in the United States Patent and Trademark Office (Sec. 2f of Lanham Act), is the Court of Appeals for the Federal Circuit correct in holding, as in the present case, that in addition to such statutory distinctiveness, it is essential to prove also strict "secondary meaning" and that by means of a "scientifically accurate survey"; these holdings being *in direct and confusing conflict* with holdings of a growing number of other Federal Circuit Courts of Appeals that strict "secondary meaning" need no longer be shown and that even "secondary meaning" does not require a "scientifically accurate survey"?

2. Can such two totally opposing legal tests be tolerated for the protection of descriptive trademarks—one enunciated by the Court of Appeals for the Federal Circuit in deciding litigation between an opposer and a trademark applicant in the United States Patent and Trademark Office, and a *diametrically contrary rule* should the opposer and applicant meet on the same issue in at least the Courts of Appeals for the Second, Fifth and Seventh Circuits, in common law trademark infringement and unfair competition litigation?

3. Can the thousands of trademark applicants who now annually apply to the United States Patent and Trademark Office under Sec. 2f of the Lanham Act, any longer rely on Congressional statutory guidelines to establish "distinctiveness" by "substantially exclusive and continuous use" in commerce for five years—a test now also adopted verbatim by a growing number of states in their intrastate trademark laws?

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**In The**
**Supreme Court of the United States**

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**No.**

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**FRANKLIN PIERCE LAW CENTER,**
**Petitioner,**

**v.**

**GEORGETOWN UNIVERSITY,**
**Respondent.**

---

# PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, Franklin Pierce Law Center, respectfully prays that a Writ of Certiorari issue to review the judgement of the United States Court of Appeals for the Federal Circuit in this case.

## RULE 29 STATEMENT

Petitioner Franklin Pierce Law Center is a New Hampshire non-profit corporation with no parent or subsidiary companies.

## OPINIONS BELOW

The opinion of the Court of Appeals for the Federal Circuit (CAFC) affirming the decision of the Trademark Trial and Appeal Board (TTAB) of the United States Department of Commerce Patent and Trademark Office (PTO), is unreported and appears as Appendix A to this petition (A. 1a-2a).

The decision of the Trademark Trial and Appeal Board, also unreported, appears in said Appendix A at A. 3a-11a.

## JURISDICTION

The judgement of the Court of Appeals was entered on January 25, 1990 and a petition for rehearing and suggestion for rehearing in banc was denied on February 23, 1990 (A. 12a). The jurisdiction of this Court is invoked pursuant to 28 U.S.C. §1254(1). This petition is filed within 90 days of the date of denial of the petition for rehearing.

## STATUTES INVOLVED

15 U.S.C. §1052(f), Lanham Act § 2(f)
15 U.S.C. § 1063

## STATEMENT OF THE CASE

Franklin Pierce Law Center (FPLC), New Hampshire's only law school and the home of the Patent Trademark and Copyright (PTC) Research Foundation, adopted the name The Journal of Law and Technology as a trademark in 1976 for concurrent use with the mark IDEA for its journal (A. 4a).

The record in this case and the undisputed facts found by the Patent and Trademark Office Trademark Trial and Appeal Board (TTAB) and concurred in by the Court of Appeals for the Federal Circuit (CAFC) show that at the time of adoption of the mark, The Journal of Law and Technology, the Law Center was the first and only entity using that mark. The mark was applied to the Law Center's journal containing articles and commentary on "science, innovation and legal systems"

(A. 5a)—the areas of speciality and the thrust underlying the very founding of the Law Center by its current president, Boston patent attorney Robert H. Rines.

For *ten years* the Law Center was the *exclusive and continuous user* of this trademark for a journal (A. 3a, 4a) until students at Georgetown University in the spring of 1986 decided, *as a new-comer,* to adopt the identical mark for a journal of their own (A. 5a), prompting the Law Center to file an application for federal registration of its common law trademark (A. 3a) with the United States Patent and Trademark Office.[1]

Recognizing the Law Center's long and exclusive prior use of this mark, the PTO examining Trademark Attorney ruled, in connection with the Law Center's application for registration,

> In view of your long use of the mark, your attention is directed to Section 2(f) of the Trademark Act (15 U.S.C. 1052(f)). A proper claim of distinctiveness should state that you believe the mark has become distinctive as applied to the goods (or services) as a result of your substantially exclusive and continuous use in commerce (specifying the type of commerce) for the five years next preceding the filing date of this application. Such a claim must be supported by an affidavit or by a declaration (37 CFR Sections 2.20 and 2.41) signed by the applicant.

Whereupon the Law Center complied with the Trademark Attorney's requirement and filed such an affidavit, fully complying with the statutory test or guidelines thus established by Congress in Sec. 2f of the so-called Lanham Act. The PTO Trademark Attorney thereupon allowed the application and passed it on for publication so that other members of the public concerned with likelihood of confusion to the public and possible damage to such members could file a notice of opposition thereto in the PTO (15 U.S.C. §1063)—i.e. a complaint, governed by the Federal Rules of Civil Procedure.

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[1] This apparently encouraged similar action by students at Harvard, though the TTAB found that "as of January 1988 the first issue had yet to be published." (A. 5a).

Georgetown accordingly filed such a notice of opposition *(Georgetown University v. Franklin Pierce Law Center Incorporated,* Opposition 76,021) to litigate these issues. The thrust of Georgetown's complaint was that "The Journal of Law and Technology" was a *generic* name (not just descriptive) and as such could never be appropriated by anyone as a trademark—it was free for everybody to use.

*Georgetown's Proofs*

At the opposition trial, Georgetown produced as witnesses a former student from its law school and a student from Harvard who testified to views as to the alleged generic, not just descriptive, character of the mark.

At no time did Georgetown ever deny that the Law Center had been the first to adopt the mark in 1976, or that the Law Center had *exclusively* and *continuously used the same in commerce for ten years* right up until Georgetown decided to adopt the mark for its 1986 publication. There is no question but that the Law Center had fully met the statutory "distinctiveness" test of Sec. 2f (assuming the mark was merely descriptive and not generic). And the TTAB so found compliance with Sec. 2f (A. 3a).

*Summary of Petitioner's Evidence on "Distinctiveness" or "Secondary Meaning"*

For its proofs, as summarized by the TTAB and the Court of Appeals, the Law Center produced the testimony of its founder and president, Robert H. Rines—totally unrebutted[2]—confirming the facts set forth in its Sec. 2f affidavit, *supra,* of the creation and adoption of the mark by the Law Center in 1976 and of the exclusive and continuous and *world-wide* use of the mark in connection with its journal for more than a decade.

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[2] The record does not contain even a scintilla of evidence, nor did the TTAB or Court of Appeals state that it did, to rebut even the *prima facie* case for first adoption in 1976 by the Law Center and for its exclusive and continuous use thereafter up until the opposer appropriated the mark "In the spring of 1986" (TTAB-A. 5a), ten years later.

The Law Center did not, however, rest on its statutory Sec. 2f distinctiveness showing, but offered further evidence—none of which was in any way discredited by Georgetown—for demonstrating the establishment of distinctiveness and the accompanying developed goodwill in the mark with customers.

As to this there is also no dispute. In the words of the TTAB and Court of Appeals, the Law Center proved the following:

1. "The applicant's evidence on this ("secondary meaning") was that the words had been used as a subtitle for IDEA since 1976 . . ." (CAFC, A. 2a).
   ". . . use of the words as either part of the title or as the subtitle on covers of applicant's journal since 1976" (TTAB, A. 7a)

   (The Law Center produced sample copies of its quarterly journals from 1976 to date with every issue carrying the mark prominently on the cover and on the upper left hand pages[3a]).

2. "much money had been spent on the journal since that date" (1976) (CAFC, A. 2a).
   "expenditure of $600,000 by applicant on the journal since 1976" (TTAB, A. 7a).

   (The Law Center circulated its journal throughout the world, as it did advertising brochures, bulletins and at its annual PTC conferences.[3b])

3. "correspondence and invoices used the word sought to be registered" (CAFC, A. 2a)
   "references by applicant and others to applicant's journal using only the words sought to be registered . . . applicant . . . use them on invoices . . . subscribers . . . use them in correspondence regarding the journal . . . (TTAB, A. 8a.).

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[3]. References to Joint Appendix (App.) in proceedings below:
a. App. 77.
b. App. 68-75, 95-97, 107-181.

(The Law Center produced 1336 invoices representing subscriptions; 40 letters dating from 1977-1979; 108 inquiries from foreign institutions; 17 documents from U.S. government agencies; 43 documents from law firms; 54 letters and forms from universities and libraries—*all using the mark and all referencing the Law Center and/or its PTC as the source of the journal.*[3c])

4. "statements from 10 people attest to the fact that they are unaware of other journals using the name . . ." (CAFC A. 2a).
"ten selected subscribers to the journal . . . unaware of anyone else using (the mark) . . ." (TTAB, A. 8a, 9a).

(The Law Center also provided these statements from select customers, such as the editor of Europe's leading intellectual property journal with *expertise* on such publications.[3d])

*Decision of TTAB*

The primary thrust of the decision of the TTAB supported Georgetown's claim that the mark was *generic* (not just descriptive) and thus incapable of being a trademark:

> *"No amount or quality of evidence of distinctiveness* can lead to registration of the common name of a thing . . . As such, they are unregistrable under Section 2(e) (1) of the Act." (A. 7a, 9a). (Emphasis added).

As a catch-all, the TTAB stated that if its

> "holding that the terms sought to be registered is a generic name for applicant's goods were to be reversed on appeal . . . (and) even if these words could somehow be determined to be only merely descriptive of the goods, rather than a generic

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c. Exhibits 3-10, App. 123-167.
d. App. 98-107.

> name for them, applicant has failed to prove that they have acquired distinctiveness . . . (A. 7a, 10a)

Specifically, even though complying with Sec. 2f of the Lanham Act, applicant did not provide a *"scientifically accurate survey"* (emphasis added) to "persuade us that distinctiveness has been attained by these words" (A. 9a).

*Decision of the Court of Appeals*

Tacitly rejecting the holding of the TTAB that the mark is inherently unregistrable as *generic,* as distinguished from descriptive, and after summarizing the Law Center evidence of distinctiveness or secondary meaning, including un-rebutted compliance with the statutory test of Sec. 2f of the Lanham Act, *supra,* the Court of Appeals affirmed the decision of the TTAB denying registration upon the conclusory ground that the Law Center did not provide "a scientifically accurate survey". (A. 2a).

It will now be shown that these requirements imposed by the Court of Appeals for the Federal circuit are *in direct, confusing and hopeless conflict* with a fast-growing body of law in other Circuit Courts of Appeals (in particular the Second, Fifth and Seventh Circuits) as to the legal requirements for proving distinctiveness. Such, indeed, unlike the requirements of the CAFC, are consistent with the philosophy underlying Sec. 2f of the Lanham Act—which very Sec. 2f has now been adopted *verbatim* by a growing number of States in their intrastate trademark laws.[4]

## REASONS FOR GRANTING THE WRIT

It is submitted that this Court should review the decision below because it conflicts with decisions of other federal courts of appeals on issues of fundamental importance in trademark

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[4] FLA. STAT. ANN. Sec. 495.021(e) (West 1987)
TEX. BUS. & COM. CODE ANN. Sec. 16.02(b) (Vernon 1987)
CAL. BUS & PROF. CODE Sec. 14220(e) (West 1987)
N.Y. GEN. BUS. LAW, Sec. 361(e) (McKinney 1984)
ILL. ANN. STAT. CH. 140, para. 9(2[e]) (Smith-Hurd 1986)

and unfair competition law, giving rise to what is now *hopeless confusion* in the different circuits.

Altogether apart from the equities of this case, recognized trademark commentators and treatise authors are also urging prompt clarification of the very issue so clearly defined in the present case:

Is the law of the land to be in the trend of the Congressional statutory *distinctiveness* (Sec. 2f), which is also the present direction in the Courts of Appeals of at least the Second, Fifth and Seventh Circuits (and of the States in adopting Sec. 2f in their intrastate laws), or does it also demand the older strict court-created "secondary meaning" requirement applied by the CAFC in this case?

The CAFC (and TTAB), as earlier discussed, while conceding unchallenged compliance with the statutory "distinctiveness" showing of Sec. 2f, have held that strict "secondary meaning" must also be shown to afford protection to a descriptive trademark.

The noted trademark commentator McCarthy[5], however, points out that

> "The 1946 Federal Lanham Act uses the term 'has become *distinctive*' . . . referring to the very same legal concept which is referred to herein as *'secondary meaning'* ". (p. 666, emphasis supplied)

He cites the above-mentioned current and growing conflicting legal requirements of the circuits, moreover, disclosing that, "even though traditional secondary meaning" is *not* proven, courts

> "led by the Federal Second Circuit in New York, have granted relief on grounds other than ('secondary meaning')." (McCarthy, *supra,* p. 669)

McCarthy entitles this the "New York Rule": "Substitutes for secondary meaning". He characterizes it as "A Break with Traditional Rules" and with the "traditional standard of

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[5] J. F. McCarthy, Trademarks and Unfair Competition, Second Edition, Vol. 1, 1984.

recovery for trademark infringement or unfair competition . . ." (McCarthy, *supra,* p. 669).

*Circuit Conflicts on Requirement for Strict "Secondary Meaning"*

Examples of such conflict are:

*Second Circuit*

> "Although secondary meaning usually is a prerequisite to trademark protection, New York law shields trade dress from deliberate copying even if it has not acquired a secondary meaning." *Harlequin Enterprises Ltd. v. Gulf & Western Corp.* 210 USPQ 1, 3; 644 F. 2d 946, 949 (2nd Cir. 1981).
>
> "But even if we assume that a secondary meaning was not established, the order still should be affirmed." *Lincoln Restaurant Corp. v. Wolfies Rest. Inc.,* 291 F. 2d 302, 303 (2nd Cir. 1961).
>
> ". . . to prove that an 'appreciable' quantum of consumers associated his name with his product in order to establish secondary meaning, was an erroneous interpretation of the law." *Yarmouth-Dion Inc. v. D'ion Furs Inc.,* 5 USPQ 2d, 1262, 1265 (2nd Cir. 1987).
>
> "Trademark infringement is a class within the general subject of unfair competition . . . The standard is the same under New York's law of unfair competition, except that under New York's law, a trademark *need not have acquired a 'secondary meaning'* or be associated in the minds of the public with its producer, in order to be unlawfully infringed." *Menley & James Laboratories, Ltd. v. Approved Pharmaceutical Corporation et al,* 195 USPQ 766, 769 (D.C. N.D. N.Y. 1977).
>
> ". . . unfair competition, notwithstanding the fact that plaintiff's mark had not yet acquired a sec-

ondary meaning . . .". *Flexitized, Inc. v. National Flexitized Corp.,* 335 F. 2d. 774, 781 (2nd Cir. 1964).

"Even where a secondary meaning has not been shown, courts will not remain passive if it appears that a producer has vested a descriptive term with a special commercial appeal . . ." *Bristol-Meyers Co. v. Approved Pharmaceutical Corp.,* 149 USPQ 896, 899 (N.Y.S.C. 1966).

*Fifth Circuit*

"Ortho was not required to show 'secondary meaning', as that term is understood in trademark law, to prevail under that section . . ." (Lanham Act, 15 U.S.C. 1125 (a)). *Chevron Chemical Co. v. Voluntary Purchasing Groups,* 659 F.2d 695, 696 (5th Cir. 1981).

"The district court also found that the Sicilia's bottle design had not acquired secondary meaning. Such a finding, however, is not a prerequisite for Sicilia to be entitled to protection." (citing *Chevron Chemical, supra). Sicilia Di R. Biebow & Co. v. Cox,* 732 F.2d 417, 426 (5th Cir. 1984).

*Seventh Circuit*

"However, secondary meaning is not necessary where the trade dress is distinctive." *Roulo v. Russ Berrie & Co.,* 12 USPQ 2d, 1423, 1427 (7th Cir. 1989).

"For 13 years Canfield was the only soft drink company using the label . . . The fact that only after . . . did companies . . . begin using the term . . . - is evidence of a secondary meaning." (Following the 2nd Circuit *Harlequin Enterprises*

case, *supra). A. J. Canfield Co. v. Vess Beverages, Inc.,* 230 USPQ 441, 443 (7th Cir. 1986).

*Other Federal Courts*

". . . the primary question in trademark infringement and unfair competition claims is whether or not the public is likely to be confused, rather than whether the senior user's trademark has acquired secondary meaning." *Marker International v. DeBruler,* 228 USPQ 906, 914 (D.C.D. Utah, 1986).

Even different panels of the TTAB disagree with the panel that decided the present case:

"the solemn declaration of appellant's substantially exclusive use for a period of five years has meaning not only from the stand point of recognition by purchasers of the product's source but also that competitors apparently recognize or have acquiesed in applicant's claim of trademark rights." *In re Synergistics Research Corp.,* 218 USPQ 165, 167 (TTAB, 1983).

*Circuit Conflicts On Necessity for "Scientific Survey"*

Not only is there conflict among the circuits (and within the circuits) as to whether strict "secondary meaning" need longer be proven to protect a descriptive mark under circumstances of long exclusive use analagous to Sec. 2f, but there is decided conflict with the further view of the CAFC in this case, that the Law Center had to provide a

"scientifically accurate survey"

to satisfy "secondary meaning" proof.

*Directly contrary* are the following decisions in other circuits:

*2nd Circuit*

"And though surveys have become the usual way of demonstrating secondary meaning . . . they are not the only way." *Centaur Communications Limited v. A/S/M Communications, Inc.,* 830 F. 2d. 1217, 1223 (2nd Cir. 1987).

*1st Circuit*

> ". . . to establish secondary meaning, survey evidence, though important . . . is not a requirement to a finding of secondary meaning." (Following the 2nd Circuit *Centaur Communications Limited* case, *supra) Kusan Inc. v. Fairway Siding Corp.*, 7 USPQ 2d 1202, 1206 (D.C.D. Mass. 1988).

*7th Circuit*

> "the existence of a survey is only one of the variety of factors . . . relevant to the issue of secondary meaning, and the plaintiff may resort to evidence other than a survey . . ." *International Kennel Club of Chicago v. Mighty Star Inc.*, 6 USPQ 2d 1977, 1982 (7th Cir. 1988).

And even a different panel of the CAFC disagrees with the current panel in your petitioner's case:

> ". . . absence of consumer surveys need not preclude a finding of acquired distinctiveness . . . To prove distinctiveness under 15 U.S.C. 1052(f), applicants may submit any appropriate evidence . . . *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 6 USPQ 2d 1001, 1010 (CAFC 1988).

So, also, do different panels of the TTAB disagree with this requirement imposed on petitioner by the TTAB panel and the CFAC in this case:

> "It is not, however, incumbent upon an applicant to conduct an exhaustive survey in order to establish a public recognition of his mark . . ." *In re The Procter & Gamble Co.*, 146 USPQ 672, 673 (TTAB 1965).

How pertinent is Derenberg's[6] comment:

> "much depends on the chance of the assignment calendar" !

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[6]. Derenberg, *Fourteenth Year of Trademark Act of 1946*, 52 Trademark Rep. 777, p. 823 (1961)

And, also, the commentary of Pattishall[7] decrying

> "the maze of contradiction and inconsistency which has so long characterized this field of law."

Other legal scholars have also been increasingly concerned with these two sets of laws for affording protection to widely used descriptive marks—one requiring proof of "secondary meaning" and the other *not* requiring strict "secondary meaning", but, rather, a showing more like the long exclusive use "distinctiveness" guideline established by Congress in Sec. 2f of the Lanham Act.

In a case comment several decades ago in the *Duke Law Journal*[8], the editors pleaded that

> "Serious consideration should be given to these implications before the "secondary meaning" requirement is either relaxed or discarded";

predicting the very confusion that now exists, and specifically noting

> "existing confusion, especially in the Second Circuit".

Thousands of yearly descriptive trademark registrants all over the country would appear to have been placed in jeopardy by this decision of the CAFC in view of their current reliance on the statutory exclusive and continuous five year use to establish "distinctiveness", and not on the proving of strict "secondary meaning", let alone by a "scientific survey".

Should, moreover, one rule of law any longer be permitted to apply to the granting of protection for descriptive trademarks in litigation between an opposer and trademark registrant, and another rule apply in litigation between the same parties in trademark infringement and unfair competition litigation?

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[7]. Pattishall, *Secondary Meaning in Trade Identity Cases; Some Questions and Suggested Answers,* 45 Trademark Rep. 1261, 1264-65 (1955)

[8]. Duke Law Journal, *Trade Name Protection: Relaxation of the 'Secondary Meaning' Requirement and Its Implications.* Vol. 1962, p. 307, p. 318, 1962.

It is believed that the present case provides the Supreme Court with an ideal opportunity to clarify and standardize the law of distinctiveness and secondary meaning in the light of this disarray of serious conflicting concepts all over the country.

The present case, with no factual disputes, affords a timely and deserving medium.

The urgency for such resolution is highlighted, moreover, by the fact that the States have now adopted the same Sec. 2f test of distinctiveness in their intrastate trademark laws. *(See footnote 4).*

Acceptance of this case will not only serve to provide long overdue clarity and uniformity to the law, but also to restore to your petitioner its hard-earned reputation residing in the world-wide established goodwill of its trademark, The Journal of Law and Technology.

## CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted.

Robert H. Rines
Counsel of Record

Nancy Richards-Stower
RINES AND RINES
81 North State Street
Concord, New Hampshire 03301
(603) 228-0121

# APPENDIX

Note: This opinion has not been prepared for publication in a printed volume because it does not add significantly to the body of law and is not of widespread legal interest. It is a public record. It is not citable as precedent. The decision will appear in tables published periodically.

## United States Court of Appeals for the Federal Circuit

**No. 89-1484**

FRANKLIN PIERCE LAW CENTER,

Appellant,

v.

GEORGETOWN UNIVERSITY,

Appellee.

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DECIDED: January 25, 1990

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Before MARKEY, *Chief Judge,* BENNETT, *Senior Circuit Judge,* NIES, *Circuit Judge.*

PER CURIAM.

DECISION

This appeal by Franklin Pierce Law Center, a New Hampshire corporation, is from a unanimous decision of the United States Patent and Trademark Office Trademark Trial and Appeal Board (board), which sustained an opposition brought by Georgetown University (Georgetown) to Franklin Pierce's proposed registration of the title "The Journal of Law and Technology," the current subtitle of its journal, IDEA. We *affirm* the board's holding.

## OPINION

The board held no secondary meaning was established here. To have held that the descriptive words have a distinctiveness for the applicant's product would have required that there be strong proof of a secondary meaning. The applicant's evidence on this was that the words had been used as a subtitle for IDEA since 1976 and that much money had been spent on the journal since that date. Further, correspondence and invoices used the words sought to be registered and statements from 10 people attest to the fact that they are unaware of other journals using the name "The Journal of Law and Technology." The board could not find that this was sufficient proof of secondary meaning in this case. Its holding was that the words were only descriptive terminology explaining what type of publication IDEA was and that length of use did not prove secondary meaning here. As to expenditures, the proof fell short of showing promotion of the words in the title or that the words have lost their descriptive significance and have acquired any secondary meaning thereby. Evidence of promotional activity was sparse. References by the applicant and others in correspondence were held insufficient to establish secondary meaning for the words in light of their highly descriptive nature. Letters by 10 subscribers solicited by the applicant with an eye toward this proceeding were held not to establish a scientifically accurate survey.

Hearing:
December 7, 1988

T. Henderson
Paper No. 23

U. S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Georgetown University
v.
Franklin Pierce Law Center, Incorporated

Opposition No. 76,021 to application Serial No. 586,218.
filed March 5, 1986.

Williams & Connolly for Georgetown University.

Rines and Rines and Nelson H. Shapiro and Ronald E. Shapiro for Franklin Pierce Law Center, Incorporated.

Before Rooney, Cissel and Quinn, Members.

Opinion by Cissel, Member:

Franklin Pierce Law Center, Inc., a New Hampshire corporation, applied to register "THE JOURNAL OF LAW AND TECHNOLOGY" on the Principal Register for "periodicals, namely journals whose contents deal with the interrelationship among science, innovation and legal systems."[1] The application is under the provisions of Section 2(f) of the Lanham Act. Applicant's claim of distinctiveness was accepted by the Examining Attorney based upon the affidavit of applicant's President, Robert Rines, who stated that as of July 1986, the words had been used exclusively and continuously for almost ten years by applicant as a trademark. No other support for the claim under Section 2(f) was either offered or requested.

[1] S.N. 586,218, filed March 5, 1986.

Timely Notice of Opposition was filed by Georgetown University, a District of Columbia corporation. As grounds for the opposition opposer asserts that the mark of applicant is merely descriptive, that it is an "apt and common term" to describe applicant's goods and that opposer itself uses the same words to describe a publication of its own. Opposer asserts that the words sought to be registered are generic, but that even if they are held to be only merely descriptive of applicant's goods, applicant has failed to establish that they have acquired secondary meaning and indicate applicant as the source of the goods. Applicant's answer is basically a denial.

The record before us includes the testimony and associated exhibits of Robert Rines, applicant's President; Ellen Dixon-Law, editor-in-chief of the Harvard Journal of Law and Technology; and Howard Jacobsen, former managing editor of the Journal of Law and Technology published by Georgetown University. Additionally, made of record by opposer's Notice of Reliance are copies of pages from various volumes of applicant's journal and covers and pages from periodical indices.

Based on this record we find that the term "JOURNAL OF LAW AND TECHNOLOGY" is an apt descriptive name for applicant's publication, and that as such, it is unregistrable as a trademark for these goods. Moreover, even if it had not been shown to be a generic term for these goods, applicant has failed to establish that it functions to identify applicant's publication and distinguish it from other similar publications.

The record shows that in 1973 applicant acquired the PTC Research Foundation from George Washington University, including the right to publish a legal periodical called "IDEA" and subtitled the "Patent Trademark and Copyright Journal of Research and Education". When applicant began publication, applicant modified the subtitle to "The PTC Journal of Research and Education." Then, in 1976, applicant began use of the present terminology, "The Journal of Law and Technology" along with "IDEA." The journal is referred to by applicant variously as "IDEA" or "IDEA THE JOUKNAL OF

LAW AND TECHNOLOGY," or as "THE JOURNAL OF LAW AND TECHNOLOGY."

In the spring of 1986, Opposer, Georgetown University, published a journal with the title "The Journal of Law and Technology". Harvard University has established a publication called "The Harvard Journal of Law and Technology", but although this publication has been organized and promoted, as of January 1988 the first issue had yet to be published.

There is no dispute as to the descriptiveness of the term sought to be registered. By making application under the provisions of Section 2(f) of the Act, applicant in effect concedes that the words are unregistrable under Section 2(e)(1) absent a showing of distinctiveness. Floss Aid Corp. v. John O. Butler Co., 205 USPQ 274 (TTAB 1979). At issue is the genericness of the term, and in the absence of proof that the term is generic, whether applicant has proved distinctiveness. A generic term can never be registered, even if there is evidence that it is associated with a single source. Miller Brewing Co. v. G. Heileman Brewing Co., 195 USPQ 281 (7th Cir. 1977), cert. denied, 434 U.S. 1025, 195 USPQ 592, (1978).

The case of In re Marvin Ginn Corp. v. Int'l Assn. of Fire Chiefs, 228 USPQ 528, 532 (Fed. Cir. 1986) sets forth a two-step inquiry for determining the genericness of a magazine title: "First, what is the class of publications or magazines at issue? Second, is the title understood by the relevant public to refer primarily to that class of magazines?" Both elements of this test are satisfied by the term sought to be registered in the case at hand.

The testimony of all three witnesses makes it quite clear that "Journal of Law and Technology" is simply an appropriate, apt descriptive name for a journal type of periodical which has as its subject the relationship between law and technology. Although applicant uses the words "science, innovation, and legal systems" in the application, the subject of the journal is described by applicant's president as "law and technology." (Rines' first deposition, p. 17: ". . . I thought this was a name that we ought to adopt as giving in the image, at the Franklin

Pierce Law School, of the pioneer law school concerned with the interfaces between law and technology.") The witnesses on behalf of opposer as well as the Harvard Law School are equally clear that they selected the words "Journal of Law and Technology" to use in combination with their school names because the words name the kind of publication they produce, or, in the case of Harvard, intend to produce.

Whether or not Harvard has actually produced a publication using these words in the title is not determinative of the case at hand. The testimony relates to the perceived meaning of these words. Georgetown has actually used them on publications generically. Although Harvard has used them in a generic sense when funds and articles to be published have been solicited, the initial issue bearing the words "Journal of Law and Technology" has not been produced. The words "Journal of Law and Technology" are no more or less generic after actual use on this kind of publication than they are prior to such use.

In a case analogous to this one, CES Publishing Corp. v. St. Regis Publications, Inc., 531 F.2d 11, 188 USPQ 612 (2d Cir. 1975), the court held "Consumer Electronics Monthly" to be generic for that type of publication. The court reasoned that it was hard to think of a name which more accurately names a class of magazines than to simply take the name of the trade which is the subject of the magazine and add to it the term "monthly". Similarly, it is difficult to describe more accurately a journal which has as its subject the interface between law and technology than by adding the words "Law and Technology" to the word "Journal." In Conde Nast Publications, Inc. v. Redbook Publishing Co., 217 USPQ 356 (TTAB 1983), the Board held "The Magazine For Young Women" to be a generic designation for such a publication, even though it had been extensively used as the subtitle for applicant's magazine. The Board noted, p. 361, that if proprietary rights were recognized in the generic designation, other such publications "would be hampered in their free use of these highly descriptive words."

In the situation now before us, Georgetown, Harvard, other institutions, or for that matter, anyone else who wants to

publish a journal on the subject of law and technology should be free to identify it using the ordinary terminology which would be understood by everyone interested in this emerging field to accurately name the kind or type of publication. Granting registration of the words "Journal of Law and Technology" to applicant or to anyone else would inhibit use by others of these generic words and therefore is not appropriate.

No amount or quality of evidence of distinctiveness can lead to registration of the common name of a thing. Miller Brewing, *supra;* Conde Nast, *supra.* If, however, the Board's holding that the term sought to be registered is a generic name for applicant's goods were to be reversed on appeal, our finding that applicant's evidence of secondary meaning is inadequate to prove distinctiveness should be noted.

The evidence applicant contends shows that "Journal of Law and Technology" has become distinctive consists of the following: (1) use of the words as either part of the title or as the subtitle on covers of applicant's journal since 1976; (2) expenditure of $600,000 by applicant on the journal since 1976; (3) invoices and correspondence showing applicant as well as others referring to applicant's journal using the words sought to be registered; and (4) written statements from ten people to the effect that they know that applicant publishes its journal and that they are unaware of other journals using the name "Journal of Law and Technology."

As to the first point, merely using descriptive terminology, even widely using it over an extensive period, does not necessarily result in such terminology acquiring secondary meaning as an indicator of source. In this case, the evidence shows that the words sought to be registered have generally been used in a descriptive sense immediately following the primary title of the journal, "IDEA." Each cover bears the heading, "IDEA" in large block letters across almost the entire width of the booklet, with "The Journal of Law and Technology" appearing directly beneath it in letters less than a fifth the size of the letters which form the word "IDEA." This evidence does not support the proposition that the words sought to be registered are perceived

as anything other than descriptive terminology explaining what type of publication "IDEA" is.

The expenditures in producing and promoting the journal hardly support the claim of distinctiveness for the words sought to be registered. There is no evidence of any extensive promotional activities, much less that the specific wording of even the complete title, "IDEA THE JOURNAL OF LAW AND TECHNOLOGY," has been widely promoted. This falls far short of proof that the final six words of the title have lost their descriptive significance and have acquired secondary meaning.

With regard to the third group of evidentiary materials submitted to show distinctiveness, the references by applicant and others to applicant's journal using only the words sought to be registered do not establish that the descriptive significance of the words has been lost. These materials show the words used in a shortened version of the title of the journal. For applicant to use them on invoices or for subscribers to use them in correspondence regarding the journal is not inconsistent with the retention of their descriptive significance. Indeed, calling the publication either "IDEA" or "THE JOURNAL OF LAW AND TECHNOLOGY" is less lengthy and less awkward than using the full title asserted by applicant, "IDEA THE JOURNAL OF LAW AND TECHNOLOGY", although there are examples of such use in the record. Evidence that a publisher or his customers correspond concerning the "LAW REVIEW" produced by the publisher would not establish that "LAW REVIEW" had become distinctive of the publication being so identified. Likewise, evidence that customers as well as the applicant in the case before us use the words, "THE JOURNAL OF LAW AND TECHNOLOGY" apart from "IDEA" to refer to applicant's journal does not establish secondary meaning for the words, especially in light of the highly descriptive nature of the words and their use by others to describe, rather than to identify, similar existing or planned publications.

The letters from subscribers similarly fail to establish secondary meaning for the words. These letters were admittedly solicited by applicant with an eye towards this proceeding. That these ten selected subscribers to the journal are familiar with its

full title, "IDEA THE JOURNAL OF LAW AND TECHNOLOGY", and are unaware of anyone else using the last six words of it does not prove that the descriptive significance of the words has been supplanted in the minds of a substantial portion of potential purchasers. This is not a scientifically accurate survey. Especially in light of the small number of people who offer their opinions in this way and the contrasting evidence that others have in fact used the same words descriptively in regard to their own publications, the letters from applicant's subscribers do not persuade us that distinctiveness has been attained by these words.

Applicant argues that other words are available to describe journals such as the one it produces, and that opposer has not met its burden of proof in that it failed to make a *prima facie* showing that the words that applicant seeks to register have not acquired distinctiveness.

The mere fact that other terms could also be used to name applicant's product does not prove that the name used by applicant is not generic. "To be held generic or a common descriptive name, it is not necessary that the designation be the only apt or common name of the goods . . ." (Conde Nast, *supra* at p. 360).

As to applicant's argument that opposer failed to meet its burden, the court in Yamaha International Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ 2d 1001 (Fed. Cir. 1988) made it abundantly clear that an applicant has the ultimate burden of establishing the registrability of its mark. Because this matter is before us for a final decision on the merits based on a full record after a complete trial, rather than in the context of an interlocutory motion prior to development of a complete record, the sole issue for our determination is which party should prevail based on the entire record. The burdens of creating or rebutting *prima facie* showings are not relevant at this stage of this opposition proceeding.

In summary, these words applicant seeks to register are the common name of the goods on which they are used. As such, they are unregistrable under Section 2(e)(1) of the Act.

Moreover, even if these words could somehow be determined to be only merely descriptive of the goods, rather than a generic name for them, applicant has failed to prove that they have acquired distinctiveness and serve to distinguish applicant's journals from those of others. Accordingly, registration under Section 2(f) of the Act is inappropriate. The opposition is sustained.

L. E. Rooney
R. F. Cissel
T. J. Quinn
Members, Trademark
Trial and Appeal Board

GJS
Paper No. 24

U. S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Georgetown University
v.
Franklin Pierce Law Center, Incorporated

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Opposition No. 76,021

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Correction

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Williams & Connolly for Georgetown University.
Rines and Rines for Franklin Pierce Law Center, Incorporated.

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Before Rooney, Cissel and Quinn, Members.
Opinion by Cissel, Member:

The Board's decision of March 2, 1989 is amended as follows:

On page 1, line 12 is amended by deleting "Nelson H. Shapiro and Ronald E. Shapiro" as counsel for applicant.

Emma S. Brown
Administrator
Trademark Trial and
Appeal Board

# ORDER

Before MARKEY, Chief Judge, NIES, Circuit Judge, and BENNETT, Senior Circuit Judge.

A petition for rehearing having been filed in this case,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, denied.

The suggestion for rehearing in banc is under consideration.

The mandate will issue on March 2, 1990.

FOR THE COURT,

Dated: February 23, 1990

Francis X. Gindhart
Clerk

cc: NANCY RICHARDS-STOWER
DANIELA WINKLER

FRANKLIN PIERCE V GEORGETOWN UNIV, 89-1484 (PTO - 76,021)

Note: This order has not been prepared for publication in a reporter.

**15 U.S.C. § 1063. Opposition to registration**

Any person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the required fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 1062 of this title of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Commissioner for good cause when requested prior to the expiration of an extension. The Commissioner shall notify the applicant of each extension of the time for filing opposition. An opposition may be amended under such conditions as may be prescribed by the Commissioner.

(As amended Jan. 2, 1975, Pub.L. 93-596, § 1, 88 Stat. 1949; Jan. 2, 1975, Pub.L. 93-600, § 1, 88 Stat. 1955; Aug. 27, 1982, Pub.L. 97-247, § 9(a), 96 Stat. 320.)

**15 U.S.C. § 1063, as amended, effective Nov. 16, 1989**

(a) Any person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 1062 of this title of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Commissioner for good cause when requested prior to the expiration of an extension. The Commissioner shall notify the applicant of each extension of the time for filing opposition. An opposition may be amended under such conditions as may be prescribed by the Commissioner.

"(b) Unless registration is successfully opposed—

"(1) a mark entitled to registration on the principal register based on an application filed under section 1051(a) or pursuant to section 1126 of this title shall be registered in the Patent and Trademark Office, a certificate of registration shall be issued, and notice of the registration shall be published in the Official Gazette of the Patent and Trademark Office; or

"(2) a notice of allowance shall be issued to the applicant if the applicant applied for registration under section 1051(b) of this title."

**15 U.S.C. § 1052(f)**

Except as expressly excluded in paragraphs (a)-(d) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Commissioner may accept as prima facie evidence that the mark has become distinctive, as applied to the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years next preceding the date of the filing of the application for its registration.

July 5, 1946, c. 540, Title I, § 2, 60 Stat. 428; Oct. 9, 1962, Pub.L. 87-772, § 2, 76 Stat. 769; Jan. 2, 1975, Pub.L. 93-596 § 1, 88 Stat. 1949.

**15 U.S.C. § 1052(f), as amended, effective Nov. 16, 1989**

Except as expressly excluded in paragraphs (a)-(d) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Commissioner may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.

**Fla. Stat. Ann. Sec. 495.021(e) (West 1988)**

The Department of State may accept as evidence that the mark has become distinctive, as applied to the applicant's goods or services, proof of continuous use thereof as a mark by the applicant in this state or elsewhere for 5 years next preceding the date of the filing of the application for registration.

**Tex. Bus. & Com. Code Ann. Sec. 16.02(b) (Vernon 1987)**

The secretary of state may accept as evidence that a mark has become distinctive as applied to the applicant's goods or services proof of substantially exclusive and continuous use of the mark by the applicant in this state for the five years next preceding the date on which the applicant filed his application for registration.

**Cal. Bus. & Prof. Code Sec. 14220(e) (West 1987)**

The Secretary of State may accept as evidence that the mark has become distinctive, as applied to the applicant's goods or services, proof of continuous use thereof as a mark by the applicant in this state or elsewhere for the five years next preceding the date of the filing of the application for registration.

**N.Y. Gen. Bus. Law, Sec. 361(e) (McKinney 1984)**

The secretary of state may accept as evidence that the mark has become distinctive, as applied to the applicant's goods or services, proof of continuous use thereof as a mark by the applicant in this state or elsewhere for the five years next preceding the date of the filing of the application for registration.

**Ill. Ann. Stat. ch. 140, para. 9(2(e)) (Smith-Hurd 1986)**

The Secretary of State may accept as evidence that the mark has become distinctive, as applied to the applicant's goods or services, proof of continuous use thereof as a mark by the applicant in this State or elsewhere for the 5 years next preceding the date of the filing of the application for registration.

Supreme Court, U.S.
FILED
JUN 22 1990
JOSEPH F. SPANIOL, JR.
CLERK

No. 89-1866

IN THE
# Supreme Court of the United States
OCTOBER TERM, 1989

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FRANKLIN PIERCE LAW CENTER,
*Petitioner,*

v.

GEORGETOWN UNIVERSITY,
*Respondent.*

---

**On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit**

---

## BRIEF IN OPPOSITION

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SCOTT BLAKE HARRIS
Counsel of Record
DANIELA WINKLER
CHRISTOPHER C. KEARNEY
WILLIAMS & CONNOLLY
839 17th Street, N.W.
Washington, D.C. 20006
(202) 331-5000
*Counsel for Respondent Georgetown University*

WILSON - EPES PRINTING CO., INC. - 789-0096 - WASHINGTON, D.C. 20001

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## QUESTION PRESENTED

1. Whether the United States Court of Appeals for the Federal Circuit erred in affirming the factual determination that there is insufficient evidence of secondary meaning in the record to permit trademark registration of petitioner's admittedly descriptive mark.

## RULE 29.1 STATEMENT

Respondent Georgetown University is a District of Columbia not for profit corporation. It has no parents or non-wholly owned subsidiaries, except that it is one of two members of a District of Columbia not for profit corporation named the Fidia-Georgetown Institute for Neurosciences, Inc.

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IN THE

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OCTOBER TERM, 1989

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No. 89-1866

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v.

GEORGETOWN UNIVERSITY,
*Respondent.*

---

**On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit**

---

## BRIEF IN OPPOSITION

---

### STATEMENT OF THE CASE

Franklin Pierce Law Center ("Franklin Pierce") petitions this Honorable Court to review the per curiam decision of the United States Court of Appeals for the Federal Circuit ("the Federal Circuit") affirming a unanimous decision by the Trademark Trial and Appeal Board ("the Board") sustaining the opposition of Georgetown University ("Georgetown") to a proposed trademark registration. Georgetown, whose law students publish a journal entitled "The Journal of Law and Technology," challenged Franklin Pierce's proposed trademark registration of the name "The Journal of Law and Technology," the current subtitle of Franklin Pierce's journal "IDEA." Georgetown argued, and the Board agreed,

that the subtitle "The Journal of Law and Technology" is unregistrable as a trademark because it is a generic name for Franklin Pierce's publication, and generic names never qualify for trademark protection. The Board further held that, even if the proposed mark were not generic, it would still be unregistrable because, as an admittedly descriptive mark, it is protectable only if it had acquired distinctiveness, or secondary meaning, and the evidence demonstrated that it had not done so.

In an exceedingly brief per curiam opinion, the Federal Circuit affirmed the unanimous decision of the Board. The Federal Circuit's one paragraph opinion summarily repeated the Board's rejection of the evidence of secondary meaning submitted by Franklin Pierce.[1] The straightforward nature of the issues presented for review is underscored by the fact that the Federal Circuit's opinion was not published "because it does not add significantly to the body of law and is not of widespread legal interest." (A. 1a).

The factual background of this case is as follows. Franklin Pierce has been the publisher of the journal "IDEA" since 1973, when it acquired the PTC Research Foundation from George Washington University and, along with it, the right to publish a legal periodical called "IDEA", which carried the subtitle "The Patent, Trademark and Copyright Journal of Research and Education." (A. 5a).

When Franklin Pierce began publishing the journal, it continued to use the title "IDEA", but changed the subtitle to "The PTC Journal of Research and Education." Franklin Pierce again changed the subtitle in 1976, when it began using the current subtitle, "The Journal of Law and Technology." (A. 5a). It is for this latest variation

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[1] The Federal Circuit, while affirming the Board's holding unqualifiedly, discussed only the issue of secondary meaning in its brief opinion and not the issue of genericness.

of the subtitle of "IDEA" that Franklin Pierce sought trademark protection.

Franklin Pierce adopted this third subtitle to describe the coverage of its journal "IDEA". Franklin Pierce's President, Robert Rines, testified that Franklin Pierce began using the subtitle "The Journal of Law and Technology" to reflect the fact that Franklin Pierce was expanding its focus of study into areas of "the interfaces between law and technology" and to establish its identity as "the pioneer law school" in this area. (A. 6a). In the spring of 1986, Georgetown first published a journal with the title "The Journal of Law and Technology". Harvard University had established (but not yet published as of the Board's opinion) a publication called "The Harvard Journal of Law and Technology". (A. 5a).

Franklin Pierce filed a trademark registration application for the name "The Journal of Law and Technology" in March 1986. (A. 3a). But in May 1986 that application was rejected because, in the Patent and Trademark Office's view, this subtitle merely described the subject matter of Franklin Pierce's journal. As the refusal stated:

> Registration is refused on the Principal Register under Section 2(e)(1) of the Trademark Act on the ground that the designation sought to be registered merely describes the subject matter of the applicant's goods. *Applicant's goods are journals concerning the fields of law and technology, and, as such, the title of the journal merely describes the primary subject matter of the goods.*

(A. 15a) (emphasis added).

In response to this rejection, Franklin Pierce amended its trademark application to seek registration under Section 2(f) of the Lanham Act, 15 U.S.C. § 1052(f) (1988). (A. 3a, 5a). That amended application acknowledged that the mark was descriptive, (A. 5a), but sought registration because the mark had acquired sec-

ondary meaning. The Patent and Trademark Office subsequently published Franklin Pierce's proposed mark for opposition. Georgetown filed a timely opposition to the proposed registration, thereby initiating the proceedings below. (A. 4a).

## REASONS FOR DENYING THE WRIT

The only issue addressed in the opinion of the Federal Circuit in this case was the factual issue whether Franklin Pierce's proposed trademark, which was admittedly descriptive, had acquired secondary meaning, and therefore was eligible for federal trademark registration. Franklin Pierce attempts to convert this issue into one appropriate for the grant of a Writ of Certiorari by erroneously asserting that "hopeless confusion" exists among United States Courts of Appeal on "issues of fundamental importance in trademark and unfair competition law." Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit ("Petition") at 7-8. Yet the only confusion that exists is that created by petitioner as a result of its misreading of the opinions below and its misinterpretation of a fundamental and essentially unquestioned tenet of trademark law: a descriptive mark (one that is not fanciful or suggestive but merely describes a product or service) is not subject to trademark registration and protection unless there is sufficient evidence of acquired distinctiveness, or secondary meaning—i.e. evidence that consumers associate the mark at issue with the registrant's product alone. *See, e.g., Carter-Wallace, Inc.* v. *Procter & Gamble Co.*, 434 F.2d 794, 802 (9th Cir. 1970).[2]

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[2] Although the Federal Circuit opinion discussed only the issue of secondary meaning, its decision affirmed the Board's holding unqualifiedly. There is no basis for Franklin Pierce's naked assertion that the Federal Circuit "[t]acitly reject[ed] the holding of the [Board] that the mark is inherently unregistrable as *generic*. . . ." Petition at 7.

The questions presented by petitioner for review, which are by no means a model of clarity, appear to be based on the following contentions: that the Federal Circuit erred by requiring a scientifically accurate survey to establish secondary meaning; that there is a conflict among the Circuits whether an admittedly descriptive mark is entitled to trademark protection in the absence of a showing of secondary meaning; and that Section 2(f) of the Lanham Act somehow abrogates the common law requirement of secondary meaning for descriptive marks. Each of these contentions is without foundation.

## I. THE CIRCUIT COURT DID NOT HOLD THAT A SCIENTIFICALLY ACCURATE SURVEY IS NECESSARY TO ESTABLISH SECONDARY MEANING

Petitioner tries to create the erroneous impression that the Federal Circuit affirmed the Board's decision to sustain Georgetown's opposition *solely* because Franklin Pierce failed to present a scientific survey establishing the secondary meaning of its purported mark, *see* Petition at 7, and that by virtue of this holding the Federal Circuit is wholly out of line with opinions of other United States Courts of Appeal concerning the necessity of such survey evidence. *Id.* at 11-12. In so doing, petitioner grossly distorts the decision of the Federal Circuit and attempts to create a conflict among the United States Courts of Appeal where none exists.

It is true that neither the Board nor the Federal Circuit gave much weight to ten letters from subscribers that were submitted by Franklin Pierce in support of its claim of secondary meaning. (A. 2a, 9a-10a). It is also true that the Board succinctly stated that this evidence was not a scientifically accurate survey. (A. 10a). Not surprisingly, the Federal Circuit agreed. (A. 2a). Neither the Board nor the Federal Circuit, however, even remotely suggested that a scientific survey is a *prerequisite* to a finding of secondary meaning. The finding of

the Board that the evidence presented by Franklin Pierce did not establish secondary meaning was not based on the lack of any acceptable survey evidence, but rather on the absence of adequate evidence of *any* kind.

The only additional evidence submitted by Franklin Pierce in an attempt to establish secondary meaning was as follows:

1. Use of the words as either part of the title or the subtitle on covers of applicant's journal since 1976;
2. The expenditure of $600,000 by Franklin Pierce on the journal as a whole since 1976;
3. Invoices and correspondence showing Franklin Pierce, as well as others, referring to applicant's journal using the words sought to be registered.

(A. 8a). The Board carefully considered each of these items and concluded that the evidence presented did not establish secondary meaning. (A. 8a-10a).

Thus, the position taken both by the Board and by the Federal Circuit is completely in line with the position taken by other courts, including those cited by petitioner, that have held that survey evidence is but one form of evidence of secondary meaning and that other evidence may suffice. *See, e.g., Centaur Communications, Ltd.* v. *A/S/M Communications, Inc.*, 830 F.2d 1217, 1223 (2d Cir. 1987); *International Kennel Club, Inc.* v. *Mighty Star, Inc.*, 846 F.2d 1079, 1086 (7th Cir. 1988); *Yamaha Int'l Corp.* v. *Hoshino Gakki Co.*, 840 F.2d 1572, 1583 (Fed. Cir. 1988).[3] Indeed, other than its misreadings of

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[3] Indeed, even if petitioner's misreading of the Federal Circuit's opinion were correct, the resulting conflict would be one within the Federal Circuit rather than one between different United States Courts of Appeal. It is well recognized that the appropriate vehicle for resolving a split within a circuit is rehearing *en banc*. Petitioner's request for such a rehearing was, not surprisingly, denied.

the opinions below in this case, petitioner does not point to any authority to the contrary. The only issue was a purely factual one—whether petitioner presented sufficient evidence to establish secondary meaning. This factual issue was carefully considered both by the Board and by the Federal Circuit, and is not appropriate for review by this Court.

## II. THERE IS NO CONFLICT AMONG THE CIRCUITS WHETHER A PARTY SEEKING REGISTRATION OF AN ADMITTEDLY DESCRIPTIVE MARK MUST PROVIDE EVIDENCE OF SECONDARY MEANING

Both the Board and Federal Circuit held that Franklin Pierce was not entitled to trademark registration because of the factual finding that it had not presented sufficient evidence to establish secondary meaning with respect to its admittedly descriptive mark. As the Federal Circuit noted:

> To have held that the descriptive words [journal of law and technology] have a distinctiveness for the applicant's product would have required that there be strong proof of a secondary meaning.

(A. 2a). Contrary to petitioner's assertion, there is no conflict among the United States Courts of Appeal whether there must be evidence of distinctiveness, or secondary meaning, before a descriptive mark may be subject to federal trademark protection. Petitioner's claim that such a conflict exists is based on no more than an erroneous reading of the very case law it cites as an exception to the rule.

Franklin Pierce points to case law from the Second, Fifth and Seventh Circuits that supposedly holds that descriptive marks are entitled to trademark protection without a showing of secondary meaning. The law in these Circuits, petitioner alleges, stands as an exception to and in conflict with the law in the other Circuits, which requires such a showing. To the contrary, how-

ever, each of these Circuits agrees that secondary meaning is a prerequisite to obtaining federal trademark protection for a descriptive mark.[4]

Petitioner first points to a number of decisions from the Second Circuit which it claims abrogate the requirement of showing secondary meaning before a descriptive mark is entitled to trademark protection. All these decisions, however, make clear that the secondary meaning requirement is abrogated *only if* the claim at issue is one of deliberate palming off or deliberately unfair business practices. *See Harlequin Enters. Ltd.* v. *Gulf & Western Corp.*, 644 F.2d 946 (2d Cir. 1981); *Flexitized, Inc.* v. *National Flexitized Corp.*, 335 F.2d 774 (2d Cir. 1964), *cert. denied*, 380 U.S. 913 (1965); *Lincoln Restaurant Corp.* v. *Wolfies Rest. Inc.*, 291 F.2d 302 (2d Cir.), *cert. denied*, 368 U.S. 889 (1961).[5] No

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[4] The Circuits have unanimously acknowledged the secondary meaning requirement. *See, e.g., Purolator, Inc.* v. *EFRA Distribs. Inc.*, 687 F.2d 554, 562 (1st Cir. 1982); *A.J. Canfield Co.* v. *Honickman*, 808 F.2d 291, 297 (3rd Cir. 1986); *Pizzeria Uno Corp.* v. *Temple*, 747 F.2d 1522, 1527 (4th Cir. 1984); *Burke-Parsons-Bowlby Corp.* v. *Appalachian Log Homes, Inc.*, 871 F.2d 590, 594 (6th Cir. 1989); *Co-Rect Prods., Inc.* v. *Marvy! Advertising Photography, Inc.*, 780 F.2d 1324, 1329 (8th Cir. 1985); *Marker Int'l* v. *DeBruler*, 844 F.2d 763, 764 (10th Cir. 1988); *American Television & Communications Corp.* v. *American Communications and Television, Inc.*, 810 F.2d 1546, 1548 (11th Cir. 1987); *Blinded Veterans Assn* v. *Blinded American Veterans Found*, 872 F.2d 1035, 1040 (D.C. Cir. 1989). *See also supra* at 4.

[5] Permitting a plaintiff to prevail on an intentional palming off or unfair competition claim without a showing of secondary meaning is precisely the "New York Rule" recited in 1 *McCarthy, Trademarks and Unfair Competition* 669 (2d ed. 1984). Petitioner offers a misleading and incomplete quotation from that treatise suggesting that the Second Circuit has abrogated the secondary meaning requirement altogether. *See* Petition at 8. A full and fair reading of McCarthy makes clear that the Second Circuit has abrogated the requirement of showing distinctiveness or secondary meaning *only* where "certain types of unfair practices may call for judicial remedies even though traditional secondary meaning and likelihood of confusion are not proven." *Id.*

such claim is at issue here. In fact, the most recent Second Circuit opinion petitioner cites explicitly reaffirms the secondary meaning requirement for trademark protection. In *Yarmuth-Dion, Inc.* v. *D'ion Furs, Inc.*, 835 F.2d 695, 702 (5th Cir. Unit A Oct. 1981), *cert. denied,* cluded that "[a]s a descriptive mark, [a] name is protectable . . . only when it has acquired secondary meaning."

The two Fifth Circuit cases petitioner relies on concerned trade dress issues pursuant to a separate statutory provision, 15 U.S.C. § 1125(a). They nevertheless affirm, rather than abrogate, the secondary meaning requirement for trade dress or marks that are merely descriptive. In *Sicilia Di R. Biebow & Co.* v. *Cox*, 732 F.2d 417, 426 (5th Cir. 1984), the Fifth Circuit held, quoting the other Fifth Circuit case petitioner cites, *Chevron Chem Co.* v. *Voluntary Purchasing Groups, Inc.*, 659 F.2d 695, 702 (5th Cir. Unit A, Oct. 1981), *cert. denied,* 457 U.S. 1126 (1982), that proof of secondary meaning was not necessary because the trade dress in question was " 'sufficiently distinctive of itself to identify the producer.' " Moreover, it went on to state that, if the trade dress at issue was "descriptive", "a finding of secondary meaning would then be required." In any event, the court distinguished trade dress from a mark, observing that one

> purpose for the secondary meaning requirement is to preserve the limited number of words and designs that are useful in describing goods and services . . . . The need to avoid monopolization of a design lessens, however, in the area of distinctive trade dress. The wide range of available packaging and design options allows a producer to appropriate a distinctive identity without unduly hindering his competitors' ability to compete.

*Id.*

Petitioners reliance on two Seventh Circuit cases is mystifying, since these cases do not in any way abrogate

the secondary meaning requirement. In fact, they both explicitly reaffirm that a showing of secondary meaning is required before a descriptive mark is protectable. In *Roulo* v. *Russ Berrie & Co.*, 886 F.2d 931, 936 (7th Cir. 1989), *cert. denied*, 110 S.Ct. 1124 (1990), the Seventh Circuit affirmed the principle that, "[i]f [a] mark is not distinctive, a showing of secondary meaning is required." The statement quoted by petitioner—that "secondary meaning is not hearsay when the trade dress is distinctive"—merely restates this principle. Similarly, in *A.J. Canfield Co.* v. *Vess Beverages, Inc.*, 796 F.2d 903, 907 (7th Cir. 1986), the Seventh Circuit applied the secondary meaning requirement and concluded, in ruling on a motion for a preliminary injunction, that "[s]ufficient evidence was introduced . . . to conclude that [plaintiff] had a better than negligible chance of demonstrating secondary meaning."

Even if the cases cited by petitioner stood for the proposition Petitioner claims they do, they would nevertheless not afford any basis upon which this Court could or should grant petitioner's writ. This is an issue which could have been but was not raised below. Petitioner could have challenged the secondary meaning requirement either before the Board or the Federal Circuit, but chose not to. Only after the Federal Circuit issued its decision did Franklin Pierce (in a Petition for Rehearing) raise the argument that its mark could be entitled to trademark protection even without a showing of secondary meaning. The Supreme Court of the United States is a court of last resort, not first resort. The conflict petitioner attempts belatedly to manufacture cannot obscure the simple fact that Franklin Pierce simply tried below but failed to demonstrate the existence of secondary meaning.

## III. SECTION 2(f) OF THE LANHAM ACT DOES NOT ABROGATE THE COMMON LAW REQUIREMENT OF SECONDARY MEANING FOR DESCRIPTIVE MARKS

Section 2(f) of the Lanham Act, 15 U.S.C. § 1052(f) (1988), is the statutory provision which concerns federal trademark registration of descriptive marks. It acknowledges that, to be registered, a descriptive mark must have acquired distinctiveness and it establishes that the Patents and Trademark Office

> *may accept* as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for . . . five years . . . (Emphasis added).

Petitioner argues that this statute, like the cited opinions from the Second, Fifth and Seventh Circuits, indicates that a descriptive mark is protectable even absent a showing of secondary meaning. Petition at 8. Yet petitioner misreads this statute just as it misreads the case law from those Circuits.

Section 2(f) incorporates, rather than abolishes, the common law on the issue of secondary meaning. It explicitly states that nothing in the Lanham Act "shall prevent the registration of a mark . . . which has become distinctive of the applicant's goods in commerce." It does not change or even affect the common law concerning secondary meaning. As the United States Court of Customs and Patent Appeals stated in *In Re Deister Concentrator Co.*, 289 F.2d 496, 501 (C.C.P.A. 1961), the Lanham Act "does not create trademarks". As it observed, "[t]here is nothing whatever in the section saying what *shall* be registered". *Id.* at 502. Accordingly, Section 2(f) leaves it to the discretion of the Board and the Courts to determine what proof is necessary to qualify

a mark for registration. *See, e.g., In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1125 (Fed. Cir. 1985). As noted above, the law is well established that a party must demonstrate that an admittedly descriptive mark like "The Journal of Law and Technology" has acquired secondary meaning before it is protectable as a trademark. This factual demonstration was the issue before the Board and the Federal Circuit and has no place for review by this Court.

## CONCLUSION

For all the reasons set forth above, Franklin Pierce's Petition for a Writ of Certiorari should be denied.

Respectfully submitted,

SCOTT BLAKE HARRIS
Counsel of Record
DANIELA WINKLER
CHRISTOPHER C. KEARNEY
WILLIAMS & CONNOLLY
839 17th Street, N.W.
Washington, D.C. 20006
(202) 331-5000
*Counsel for Respondent*
*Georgetown University*

# APPENDIX

# APPENDIX

## APPENDIX

Note: This opinion has not been prepared for publication in a printed volume because it does not add significantly to the body of law and is not of widespread legal interest. It is a public record. It is not citable as precedent. The decision will appear in tables published periodically.

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

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No. 89-1484

FRANKLIN PIERCE LAW CENTER,
*Appellant,*

v.

GEORGETOWN UNIVERSITY,
*Appellee.*

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DECIDED: January 25, 1990

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Before MARKEY, *Chief Judge*, BENNETT, *Senior Circuit Judge*, NIES, *Circuit Judge.*

PER CURIAM.

DECISION

This appeal by Franklin Pierce Law Center, a New Hampshire corporation, is from a unanimous decision of the United States Patent and Trademark Office Trademark Trial and Appeal Board (board), which sustained an opposition brought by Georgetown University (Georgetown) to Franklin Pierce's proposed registration of the

title "The Journal of Law and Technology," the current subtitle of its journal, IDEA. We *affirm* the board's holding.

## OPINION

The board held no secondary meaning was established here. To have held that the descriptive words have a distinctiveness for the applicant's product would have required that there be strong proof of a secondary meaning. The applicant's evidence on this was that the words had been used as a subtitle for IDEA since 1976 and that much money had been spent on the journal since that date. Further, correspondence and invoices used the words sought to be registered and statements from 10 people attest to the fact that they are unaware of other journals using the name "The Journal of Law and Technology." The board could not find that this was sufficient proof of secondary meaning in this case. Its holding was that the words were only descriptive terminology explaining what type of publication IDEA was and that length of use did not prove secondary meaning here. As to expenditures, the proof fell short of showing promotion of the words in the title or that the words have lost their descriptive significance and have acquired any secondary meaning thereby. Evidence of promotional activity was sparse. References by the applicant and others in correspondence were held insufficient to establish secondary meaning for the words in light of their highly descriptive nature. Letters by 10 subscribers solicited by the applicant with an eye toward this proceeding were held not to establish a scientifically accurate survey.

Hearing:
December 7, 1988

T. Henderson
Paper No. 23

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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GEORGETOWN UNIVERSITY

v.

FRANKLIN PIERCE LAW CENTER, INCORPORATED

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Opposition No. 76,021 to application Serial No. 586,218

Filed March 5, 1986

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Williams & Connolly for Georgetown University.

Rines and Rines and Nelson H. Shapiro and Ronald E. Shapiro for Franklin Pierce Law Center, Incorporated.

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Before Rooney, Cissel and Quinn, Members.

Opinion by Cissel, Member:

Franklin Pierce Law Center, Inc., a New Hampshire corporation, applied to register "THE JOURNAL OF LAW AND TECHNOLOGY" on the Principal Register for "periodicals, namely journals whose contents deal with the interrelationship among science, innovation and legal systems." [1] The application is under the provisions of Section 2(f) of the Lanham Act. Applicant's

[1] S.N. 586,218, filed March 5, 1986.

claim of distinctiveness was accepted by the Examining Attorney based upon the affidavit of applicant's President, Robert Rines, who stated that as of July 1986, the words had been used exclusively and continuously for almost ten years by applicant as a trademark. No other support for the claim under Section 2(f) was either offered or requested.

Timely Notice of Opposition was filed by Georgetown University, a District of Columbia corporation. As grounds for the opposition opposer asserts that the mark of applicant is merely descriptive, that it is an "apt and common term" to describe applicant's goods and that opposer itself uses the same words to describe a publication of its own. Opposer asserts that the words sought to be registered are generic, but that even if they are held to be only merely descriptive of applicant's goods, applicant has failed to establish that they have acquired secondary meaning and indicate applicant as the source of the goods. Applicant's answer is basically a denial.

The record before us includes the testimony and associated exhibits of Robert Rines, applicant's President; Ellen Dixon-Law, editor-in-chief of the Harvard Journal of Law and Technology; and Howard Jacobsen, former managing editor of the Journal of Law and Technology published by Georgetown University. Additionally, made of record by opposer's Notice of Reliance are copies of pages from various volumes of applicant's journal and covers and pages from periodical indices.

Based on this record we find that the term "JOURNAL OF LAW AND TECHNOLOGY" is an apt descriptive name for applicant's publication, and that as such, it is unregistrable as a trademark for these goods. Moreover, even if it had not been shown to be a generic term for these goods, applicant has failed to establish that it functions to identify applicant's publication and distinguish it from other similar publications.

The record shows that in 1973 applicant acquired the PTC Research Foundation from George Washington University, including the right to publish a legal periodical called "IDEA" and subtitled the "Patent Trademark and Copyright Journal of Research and Education". When applicant began publication, applicant modified the subtitle to "The PTC Journal of Research and Education." Then, in 1976, applicant began use of the present terminology, 'The Journal of Law and Technology" along with "IDEA." The journal is referred to by applicant variously as "IDEA" or "IDEA THE JOURNAL OF LAW AND TECHNOLOGY," or as "THE JOURNAL OF LAW AND TECHNOLOGY."

In the spring of 1986, Opposer, Georgetown University, published a journal with the title "The Journal of Law and Technology... Harvard University has established a publication called "The Harvard Journal of Law and Technology", but although this publication has been organized and promoted, as of January 1988 the first issue had yet to be published.

There is no dispute as to the descriptiveness of the term sought to be registered. By making application under the provisions of Section 2(f) of the Act, applicant in effect concedes that the words are unregistrable under Section 2(e)(1) absent a showing of distinctiveness. Floss Aid Corp. v. John O. Butler Co., 205 USPQ 274 (TTAB 1979). At issue is the genericness of the term, and in the absence of proof that the term is generic, whether applicant has proved distinctiveness. A generic term can never be registered, even if there is evidence that it is associated with a single source. Miller Brewing Co. v. G. Heileman Brewing Co., 195 USPQ 281 (7th Cir. 1977), cert. denied, 434 U.S. 1025, 195 USPQ 591, (1978).

The case In re Marvin Ginn Corp. v. Int'l Assn. of Fire Chiefs, 228 USPQ 528, 532 (Fed. Cir. 1986) sets forth

a two-step inquiry for determining the genericness of a magazine title: "First, what is the class of publications or magazines at issue? Second, is the title understood by the relevant public to refer primarily to that class of magazines?" Both elements of this test are satisfied by the term sought to be registered in the case at hand.

The testimony of all three witnesses makes it quite clear that "Journal of Law and Technology" is simply an appropriate, apt descriptive name for a journal type of periodical which has as it subject the relationship between law and technology. Although applicant uses the words "science, innovation, and legal systems" in the application, the subject of the journal is described by applicant's president as "law and technology." (Rines' first deposition, p. 17: ". . . I thought this was a name that we ought to adopt as giving in the image, at the Franklin Pierce Law School, of the pioneer law school concerned with the interfaces between law and technology.") The witnesses on behalf of opposer as well as the Harvard Law School are equally clear that they selected the words "Journal of Law and Technology" to use in combination with their school names because the words name the kind of publication they produce, or, in the case of Harvard, intend to produce.

Whether or not Harvard has actually produced a publication using these words in the title is not determinative of the case at hand. The testimony relates to the perceived meaning of these words. Georgetown has actually used them on publications generically. Although Harvard has used them in a generic sense when funds and articles to be published have been solicited, the initial issue bearing the words "Journal of Law and Technology" has not been produced. The words "Journal of Law and Technology" are not more or less generic after actual use on this kind of publication than they are prior to such use.

In a case analogous to this one, CES Publishing Corp. v. St. Regis Publications, Inc., 531 F.2d 11, 188 USPQ 612 (2d Cir. 1975), the court held "Consumer Electronics Monthly" to be generic for that type of publication. The court reasoned that it was hard to think of a name which more accurately names a class of magazines than to simply take the name of the trade which is the subject of the magazine and add to it the term "monthly". Similarly, it is difficult to describe more accurately a journal which has as it subject the interface between law and technology than by adding the words "Law and Technology" to the word "Journal." In Conde Nast Publications, Inc. v. Redbook Publishing Co., 217 USPQ 356 (TTAB 1983), the Board held "The Magazine For Young Women" to be a generic designation for such a publication, even though it had been extensively used as the subtitle for applicant's magazine. The Board noted, p. 361, that if proprietary rights were recognized in the generic designation, other such publications "would be hampered in their free use of these highly descriptive words."

In the situation now before us, Georgetown, Harvard, other institutions, or for that matter, anyone else who wants to publish a journal on the subject of law and technology should be free to identify it using the ordinary terminology which would be understood by everyone interested in this emerging field to accurately name the kind or type of publication. Granting registration of the words "Journal of Law and Technology" to applicant or to anyone else would inhibit use by others of these generic words and therefore is not appropriate.

No amount or quality of evidence of distinctiveness can lead to registration of the common name of a thing. Miller Brewing, *supra;* Conde Nast, *supra.* If, however, the Board's holding that the term sought to be registered is a generic name for applicant's goods were to be reversed on appeal, our finding that applicant's evidence of

secondary meaning is inadequate to prove distinctiveness should be noted.

The evidence applicant contends shows that "Journal of Law and Technology" has become distinctive consists of the following: (1) use of the words as either part of the title or as the subtitle on covers of applicant's journal since 1976; (2) expenditure of $600,000 by applicant on the journal since 1976; (3) invoices and correspondence showing applicant as well as others referring to applicant's journal using the words sought to be registered; and (4) written statements from ten people to the effect that they know that applicant publishes its journal and that they are unaware of other journals using the name "Journal of Law and Technology."

As to the first point, merely using descriptive terminology, even widely using it over an extensive period, does not necessarily result in such terminology acquiring secondary meaning as an indicator of source. In this case, the evidence shows that the words sought to be registered have generally been used in a descriptive sense immediately following the primary title of the journal, "IDEA." Each cover bears the heading, "IDEA" in large block letters across almost the entire width of the booklet, with "The Journal of Law and Technology" appearing directly beneath it in letters less than a fifth the size of the letters which form the word "IDEA." This evidence does not support the proposition that the words sought to be registered are perceived as anything other than descriptive terminology explaining what type of publication "IDEA" is.

The expenditures in producing and promoting the journal hardly support the claim of distinctiveness for the words sought to be registered. There is no evidence of any extensive promotional activities, much less that the specific words of even the complete title, "IDEA THE JOURNAL OF LAW AND TECHNOLOGY," has been

widely promoted. This falls far short of proof that the final six words of the title have lost their descriptive significance and have acquired secondary meaning.

With regard to the third group of evidentiary materials submitted to show distinctiveness, the references by applicant and others to applicant's journal using only the words sought to be registered do not establish that the descriptive significance of the words has been lost. These materials show the words used in a shortened version of the title of the journal. For applicant to use them on invoices or for subscribers to use them in correspondence regarding the journal is not inconsistent with the retention of their descriptive significance. Indeed, calling the publication either "IDEA" or "THE JOURNAL OF LAW AND TECHNOLOGY" is less lengthy and less awkward than using the full title asserted by applicant, "IDEA THE JOURNAL OF LAW AND TECHNOLOGY", although there are examples of such use in the record. Evidence that a publisher or his customers correspond concerning the "LAW REVIEW" produced by the publisher would not establish that "LAW REVIEW" had become distinctive of the publication being so identified. Likewise, evidence that customers as well as the applicant in the case before us use the words, "THE JOURNAL OF LAW AND TECHNOLOGY" apart from "IDEA" to refer to applicant's journal does not establish secondary meaning for the words, especially in light of the highly descriptive nature of the words and their use by other to describe, rather than to identify, similar existing or planned publications.

The letters from subscribers similarly fail to establish secondary meaning for the words. These letters were admittedly solicited by applicant with an eye towards this proceeding. That these ten selected subscribers to the journal are familiar with its full title, "IDEA THE JOURNAL OF LAW AND TECHNOLOGY", and are unaware of anyone else using the last six words of it

does not prove that the descriptive significance of the words has been supplanted in the minds of a substantial portion of potential purchasers. This is not a scientifically accurate survey. Especially in light of the small number of people who offer their opinions in this way and the contrasting evidence that others have in fact used the same words descriptively in regard to their own publications, the letters from applicant's subscribers do not persuade us that distinctiveness has been attained by these words.

Applicant argues that other words are available to describe journals such as the one if produces, and that opposer has not met its burden of proof in that it failed to make a *prima facie* showing that the words that applicant seeks to register have not acquired distinctiveness.

The mere fact that other terms could also be used to name applicant's product does not prove that the name used by applicant is not generic. "To be held generic or a common descriptive name, it is not necessary that the designation be the only apt or common name of the goods . . ." (Conde Nast, *supra* at p. 360).

As to applicant's argument that opposer failed to meet its burden, the court in Yamaha International Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ 2d 1001 (Fed. Cir. 1988) made it abundantly clear that an applicant has the ultimate burden of establishing the registrability of its mark. Because this matter is before us for a final decision on the merits based on a full record after a complete trial, rather than in the context of an interlocutory motion prior to development of a complete record, the sole issue for our determination is which party should prevail based on the entire record. The burdens of creating or rebutting *prima facie* showings are not relevant at this stage of this opposition proceeding.

In summary, these words applicant seeks to register are the common name of the goods on which they are used. As such, they are unregistrable under Section 2(e)(1) of the Act. Moreover, even if these words could somehow be determined to be only merely descriptive of the goods, rather than a generic name for them, applicant has failed to prove that they have acquired distinctiveness and serve to distinguish applicant's journals from those of others. Accordingly, registration under Section 2(f) of the Act is inappropriate. The opposition is sustained.

L. E. Rooney
R. F. Cissel
T. J. Quinn
Members, Trademark
Trial and Appeal Board

GJS
Paper No. 24

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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GEORGETOWN UNIVERSITY

v.

FRANKLIN PIERCE LAW CENTER, INCORPORATED

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Opposition No. 76,021

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Correction

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Williams & Connolly for Georgetown University.

Rines and Rines for Franklin Pierce Law Center, Incorporated.

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Before Rooney, Cissel and Quinn, Members.

Opinion by Cissel, Member:

The Board's decision of March 2, 1989 is amended as follows:

On page 1, line 12 is amended by deleting "Nelson H. Shapiro and Ronald E. Shapiro" as counsel for applicant.

Emma S. Brown
Administrator
Trademark Trial and
Appeal Board

## ORDER

Before MARKEY, Chief Judge, NIES, Circuit Judge, and BENNETT, Senior Circuit Judge.

A petition for rehearing having been filed in this case,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, denied.

The suggestion for rehearing in banc is under consideration.

The mandate will issue on March 2, 1990.

FOR THE COURT,

Dated: February 23, 1990

Francis X. Gindhart
Clerk

cc: NANCY RICHARDS-STOWER
DANIELA WINKLER

FRANKLIN PIERCE V GEORGETOWN UNIV, 89-1484 (PTO—76,021)

Note: This order has not been prepared for publication in a reporter.

U.S. DEPARTMENT OF COMMERCE—
Patent and Trademark Office

IN REPLY REFER TO THE FOLLOWING AND THE FILING DATE:

SERIAL NO.

[Illegible]

APPLICANT
PTC RESEARCH FOUNDATION

MARK

THE JOURNAL OF LAW AND TECHNOLOGY

ADDRESS

ROBERT H. RINES
RINES AND RINES
81 NORTH STATE STREET
CONCORD, NEW HAMPSHIRE 03301

ACTION NO.
01

MAILING DATE
05/15/86

Paper No.

ADDRESS:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

The address of all correspondence not containing fee payments should include the word "Box 5."

AM PTO-1525 (2-84)
U.S. Dept. of Comm. Pat. & TM Office

Also furnish: (1) Serial number of application, (2) The mark, (3) Examining Attorney's name and Law Office number, (4) Mailing date of this action, and (5) Applicant's name (or applicant's attorney), telephone number and zip code.

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT.

Registration is refused on the Principal Register under Section 2(e)(1) of the Trademark Act on the ground that the designation sought to be registered merely describes the subject matter of applicant's goods. Applicant's goods are journals concerning the fields of law and technology, and, as such, the title of the journal merely describes the primary subject matter of the goods.

The Trademark Trial and Appeal Board and the Courts have consistently held marks which describe the subject matter of publications merely descriptive within the meaning of Section 2(e)(1) of the Act. *Trade Publications, v Big Bear of North Carolina, Inc.*, 191 USPQ 477 (M.D.N.C. 1976) (FOOD WORLD descriptive of magazine); *In re The Gracious Lady Service, Inc.*, 175 USPQ 380 (TTAB 1972) (*CREDIT CARD MARKETING* descriptive of periodic pamphlet); *Sterling House, Inc. v. Dell Publishing Co., Inc.*, 174 USPQ 299 (S.D.N.Y. 1972) (DAYTIME TV descriptive of a magazine); *In re Nippon Kokan Kabushiki Kaisha*, 171 USPQ 63 (TTAB 1971) (JAPAN STEEL NOTES descriptive of magazine); *Field Enterprises Educational Corporation v. Cove Industries Incorporated*, 161 USPQ 243 (E.D.N.Y.1969) (WORLD BOOK descriptive of encyclopedia); *In re Medical Digest, Inc.*, 148 USPQ 570 (TTAB 1965) (OB/GYN DIGEST descriptive of magazine); *Ex parte Motor Trend Publications Inc.*, 98 USPQ 26 (TTAB 1953) (MOTOR TREND descriptive of mag-

azines); *In re National Recreation Association, Inc.*, 85 USPQ 281 (CCPA 1950) THE PLAYGROUND descriptive of magazine); *McGraw-Hill Publishing Company, Inc. v. American Aviation Associates, Inc.*, 47 USPQ 494 (D.C. Cir. 1940) (AVIATION descriptive of magazine); *cf. Technical Publishing Company v. Lebhar-Friedman, Inc.*, 222 USPQ 839 (7th Cir. 1984) (SOFTWARE NEWS held generic for magazines); *Walker-Davis Publications, Inc. v. Penton/IPC, Inc.*, 211 USPQ 665 (E.D. Pa. 1981) (ENERGY MANAGEMENT generic as applied to publications); *Reese Publishing Company, Inc.* v. *Hampton International Communications, Inc.*, 205 USPQ 585 (2nd Cir. 1980) (VIDEO BUYER'S GUIDE so highly descriptive as to be incapable of functioning as a trademark for a publication); *CES Publishing Corp. v. St. Regis Publications, Inc.*, 188 USPQ 612 (2nd Cir. 1975) (CONSUMER ELECTRONICS generic as applied to publication); *In re World Library Publications, Inc.*, 198 USPQ 442 (TTAB 1978) (PEOPLE'S MASS BOOK generic as to hymn books); *Jenkins Publishing Co. v. Metalworking Publishing Co., Inc.*, 139 USPQ 346 (TTAB 1963) METALWORKING so highly descriptive as to be incapable of exclusive appropriation as applied to a publication).

In view of your long use of the mark, your attention is directed to Section 2(f) of the Trademark Act (15 U.S.C. 1052(f)). A proper claim of distinctiveness should state that you believe the mark has become distinctive as applied to the goods (or services) as a result of your substantially exclusive and continuous use in commerce (specifying the type of commerce) for the five years next preceding the filing date of this application. Such a claim must be supported by an affidavit or by a declaration (37 CFR Sections 2.20 and 2.41) signed by the applicant.

The term periodicals in the identification of goods is indefinite. Applicant may amend to periodicals, namely, journals . . . .

The term journal must be disclaimed as the generic name for applicant's goods.

You must insert a disclaimer of journal in the application. (See 15 U.S.C. 1056; TMEP section 904.06.)

A properly worded disclaimer should read as follows:

> No claim is made to the exclusive right to use journal, apart from the mark as shown.

According to my search of the Office registration records, there is no registered mark which so resembles the applicant's mark, when applied to the goods (or services), as to be likely to cause confusion, or to cause mistake, or to deceive. (15 U.S.C. 1052(d); TMEP section 1105.01.)

/s/ Mary C. Mack
MARY MACK
Trademark Attorney, Law Office I
703 557-3273

M:SW4

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No. 89-1866

IN THE

# Supreme Court of The United States

October Term, 1989

FRANKLIN PIERCE LAW CENTER,
*Petitioner*

v.

GEORGETOWN UNIVERSITY,
*Respondent*

**On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit**

## PETITIONER'S REPLY TO BRIEF IN OPPOSITION

Robert H. Rines
*Counsel of Record*

Nancy Richards-Stower
RINES AND RINES
81 North State Street
Concord, New Hampshire
(603) 228-0121
*Attorneys for the Petitioner*

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# PETITIONER'S REPLY TO BRIEF IN OPPOSITION

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The respondent, in its brief in opposition to the petition for certiorari, states that this case involves only a mere "factual" dispute as to whether petitioner proved secondary meaning of its descriptive trademark, and that petitioner misconstrues the law and cases cited and has only manufactured a conflict of law, so that the attention of this Court is not warranted.

Respondent, however, concedes that petitioner *did comply* with the requirement of the trademark examining attorney for a showing of *statutory secondary meaning,* called *"distinctiveness"* (Sec. 2f of the Lanham Act)[1] and that the facts of such showing were true[1].

*There Are No Facts In Dispute*

Petitioner has relied on the facts found by the Board and summarized by the Court of Appeals and now again admitted by respondent in its brief; namely,

A. Petitioner was the *first* to create, adopt and use the mark "in 1976" and has used it continuously since that date on its journal[1].

B. Petitioner complied with the Patent Office requirement, enunciated by the trademark examining attorney (R.B.-Appendix p. 16a), to satisfy the Sec. 2f showing of *statutory distinctiveness* (secondary meaning), demonstrating over five years of exclusive and continuous use of the mark in commerce[2].

C. The trademark examining attorney held that respondent had so complied, and allowed and published the application for registration.

D. Respondent—*ten years after petitioner*—"in the spring of 1986", just appropriated petitioner's trademark and deliberately started to use it on a competing law journal[3].

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[1] Respondent's brief is herein referred to as "R.B.". R.B. p. 3 bottom, p. 4 top; Appendix-bottom p. 16a.

[2] R.B. p. 2, ". . . in 1976, when it (Franklin Pierce Law Center) began using the current subtitle, 'The Journal of Law and Technology' ". p. 6, "Use . . . on covers of applicant's journal since 1976".

[3] R.B. p. 3, "In the spring of 1986, Georgetown first published a journal with the title 'The Journal of Law and Technology' ".

E. Petitioner, in addition to its showing of *statutory distinctiveness* (secondary meaning), provided other showings conventional to *common law secondary meaning*[4]; namely, in respondent's words:

"1. Use of the words as either part of the title or subtitle on covers of applicant's journal since 1976;

2. The expenditure of $600,000 by Franklin Pierce on the journal as a whole since 1976;

3. Invoices and correspondence showing Franklin Pierce, as well as others, referring to applicant's journal using the words sought to be registered." (R.B. p. 6).

F. The Board and the Court of Appeals "succinctly stated that this evidence was not a scientifically accurate survey." (R.B., p. 5).

*The Pressing Legal Question Before This Court*

Almost ignored by respondent is the *real issue* before this Court:

Is a showing of "common law" secondary meaning required for protection of a descriptive trademark where there is *admitted full compliance* with the showing of *statutory* secondary meaning ("distinctiveness")—a route deliberately created by Congress for this *sole purpose* of protecting otherwise descriptive trademarks?

Congress listened to 22 years[5] of debate as to whether to provide for *statutory* secondary meaning as opposed to *common law* secondary meaning for descriptive marks, and decided to set at least a minimum *statutory* standard *(not strict common law)* by Sec. 2f.

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[4] Respondent takes issue with petitioner's assertion that the Court of Appeals did not follow the Board in holding the mark "generic". Clearly, if the mark were "generic", then, as correctly stated by the Board, "no amount or quality of evidence of distinctiveness can lead to registration of the common name of a thing . . . As such, they are unregistrable under Section 2(e)(1) of the Act." (A. 7a, 9a). The Court of Appeals clearly treated with requirements of secondary meaning which have absolutely no significance had the mark been generic.

[5] Commencing with hearings on S.2679, 68th Cong. 2d Sess.

Is the Congressional *statutory* secondary meaning with which petitioner admittedly fully complied and which the Patent and Trademark Examiner ruled sufficient, actually a dead letter, as this decision would seem to say?

*Respondent Concedes 2nd Circuit Court of Appeals "Abrogates" Common Law Secondary Meaning Requirement In Appropriate Cases*

And while charging that there is no confusion or conflict in the various courts[6] and that petitioner has misunderstood or misquoted the cases, and even manufactured a supposed conflict, even respondent admits that the Court of Appeals of the Second Circuit has *abandoned* the requirement of a showing of full common law secondary meaning, and indeed looked to the long exclusive use by a first-comer, totally analogous to the minimum *statutory* distinctiveness requirements of Sec. 2f.

Specifically, respondent concedes that (R.B. p. 8):

> "the Second Circuit has abrogated the requirement of showing distinctiveness or secondary meaning *only* where 'certain types of unfair practices may call for judicial remedies even though traditional secondary meaning and likelihood of confusion are not proven.' "

And then respondent states that such

> ". . . Second Circuit . . . decisions, however, make clear that the secondary meaning requirement is abrogated *only* if the claim at issue is one of deliberate palming off or deliberately unfair business practices".

*But that is precisely what is involved in this very case.*

By its own admission, respondent appropriated petitioner's exact mark *ten years later* ("in 1986", R.B. p. 3) and started competing with petitioner with a brand new law journal,

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[6] Contrary to respondent's criticism, petitioner seasonably raised the conflict of law issue before the Court of Appeals in its petition for rehearing.

deliberately[7] and prominently using petitioner's established mark (and, indeed, without even using respondent's name near or in association with the mark).[8]

*Conclusion*

Clearly petitioner has correctly represented to this Court that there is a real and pressing issue and current conflict of understanding in the law of the protection of descriptive marks that call out for prompt clarification by the Supreme Court in the national *(and international)* interest.

It is significant that respondent has not in the slightest taken issue with petitioner's assertion (p. 13 of the petition) that thousands of yearly descriptive—trademark registrants all over the country would appear to have been placed in jeopardy by this decision of the CAFC in view of PTO applicants' current reliance on the *statutory* exclusive and continuous five year use to establish "distinctiveness", as opposed to a requirement of proving common law "secondary meaning", let alone by a "scientific survey".

It is urged, accordingly, that the petition should be granted.

Respectfully submitted.

Robert H. Rines
Counsel of Record

Nancy Richards-Stower
RINES AND RINES
81 North State Street
Concord, New Hampshire 03301
(603) 228-0121

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[7] Respondent was put on notice of petitioner's much earlier and world-wide use of the mark, but *deliberately* went ahead anyway. (Joint App.-CAFC-p. 80)

[8] Joint App.-CAFC-p. 213.